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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/620,953 07/21/00 GRAEF

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026389

QM32/0731

EXAMINER

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SEATTLE WA 98101-2347

RUHL, D

ART UNIT

PAPER NUMBER

3761

DATE MAILED:

07/31/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/620,953

Applicant(s)

GRAEF ET AL.

Examiner

Dennis Ruhl

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2001. 5/17/01 *DR*
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892) ✓
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 3761

Applicant's response of 5-17-01 has been entered. With respect to the invention claimed in the pending claims at first glance the examiner thought an election of species was required; however, after a further in depth review of the claims the examiner has concluded that applicant is claiming only one species of the invention (with some generic claims). The claims are directed to the species where the 1<sup>st</sup> stratum comprises hydrophobic synthetic fibers and a binder where the 2<sup>nd</sup> stratum is comprised of hydrophilic crosslinked cellulose fibers (eucalyptus) and a binder. The examiner considers this species to be elected by original presentation as there are no other claims to any of the other disclosed species. For this reason the examiner has examined all of the claims and will not impose a species requirement.

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

The Oath only indicates "same" in the post office address portion. This is not a valid post office address. Also there is no indication of what "same" means. "same" as what? A new Oath is required.

2. The disclosure is objected to because of the following informalities: Applicant has referred to various application numbers at pages 11,13,15, and 18. Applicant needs to update the status of the referred to application numbers and indicate a patent number if

Art Unit: 3761

in fact the applications have issued. This is especially important when applicant is incorporating by reference older applications as is the case here.

Appropriate correction is required.

3. The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

4. The specification is objected to under 37 CFR 1.71 because the specification as originally filed fails to provide support for the claim limitation of claims 4,9,14,19,29,34, 39,44, 52,55,58,61. The recitation of the binder (not really clear which one, see 112,2<sup>nd</sup> below) is at least one of bicomponent fibers and a wet strength agent is considered to be new matter. These claims includes the situation where the binder is both the bicomponent fiber and the wet strength agent. This is new matter that has been added to the specification. The examiner could not find support as originally filed (see 09/137,503) for the binder being two things (a fiber and a wet strength agent). The

Art Unit: 3761

specification as originally filed only discloses that the layers of the composite each have a binder (not more than one binder). This application is a continuation of 09/137,503 so the disclosure must be commensurate with what was disclosed in the parent case.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 4,9,14,19,29,34,39,44,52,55,58,61, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims are rejected for the same reasons as was set forth in the objection to the specification under 37 CFR 1.71.

Applicant is required to cancel the new matter in the reply to this Office Action.

7. Claims 1-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims ~~1,6,11,16,26,31,36,41,51,54,57,60~~, there is no antecedent basis for the following: "the first and second strata". How many layers are being claimed here? Earlier in the claim there is a recitation of "first stratum" and "second stratum". It is not clear what the recitation of "the first and second strata" refer to.

Art Unit: 3761

With respect to claims ~~2,7,12,17~~, what hydrophobic fibers are being referred to here? The hydrophobic fibers of the 1<sup>st</sup> or 2<sup>nd</sup> stratum? This is not clear.

With respect to claims ~~3,8,13,18~~, is applicant now reciting that the fibers of the 2<sup>nd</sup> stratum are in fact the hydrophilic fibers of the Markush group of the independent claims? The examiner does not know if applicant is now claiming that the fibers of the 2<sup>nd</sup> stratum are in fact hydrophilic, or if applicant is just limiting one of the member of the Markush group but where the fibers are still any one of the members of the Markush group (and not necessarily hydrophilic fibers). This is not clear to the examiner.

With respect to claims ~~4,9,14,19,29,34,39,44,52,55,58,61~~, what binder is being referred to here? The binder of the 1<sup>st</sup> stratum or the 2<sup>nd</sup> stratum? This is not clear

With respect to claims ~~5,10,15,30,35,40,53,56,59~~, the examiner does not understand how the claimed article can be at least one of (may be all of the them) a feminine care product, an infant diaper and an adult incontinence product. The claim includes the situation where the article is all three of the recited articles and this does not seem possible. Did applicant possibly intend to recite "wherein the article is one of a feminine care product, an infant diaper, etc...".

With respect to claims ~~24,25,49,50,66,67~~, what hydrophilic fibers are being referred to here? Is this the hydrophilic fibers of the distribution stratum or the hydrophilic fibers of the 2<sup>nd</sup> stratum? If this is referring to the hydrophilic fibers of the 2<sup>nd</sup> stratum does this mean that applicant is now reciting that the fibers of the 2<sup>nd</sup> stratum are in fact hydrophilic as opposed to being any one of the members of the Markush group? This is not clear.

Art Unit: 3761

Correction of all of the above is required.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1,2,4-7,9-12,14,15,26,27,29-32,34-37,39,40, are rejected under 35 U.S.C. 102(b) as being anticipated by Young Sr. et al. (5188624).

With respect to claims 1,2,4,5,6,7,9,10,11,12,14,15,26,27,29,30,31,32,34,35, 36,37,39,40, Young discloses a 1<sup>st</sup> stratum 14 and a 2<sup>nd</sup> stratum 16. The 1<sup>st</sup> stratum is made from hydrophobic fibers and a binder. See columns 6, lines 49-53 and column 5, lines 40-58. The 2<sup>nd</sup> stratum is made from the claimed fibers and a binder. See column 7, lines 24-28, column 8, lines 3-9 and column 7, lines 30-32. With respect to the entanglement of the fibers at the interface of the stratum see column 3, lines 54-57 and column 7, lines 12-16.

With respect to claim 6, in addition to what is discussed in the preceding paragraph, Young discloses a topsheet 12 and a backsheet 18.

With respect to claims 11,36, Young discloses a storage stratum 20 that is fibrous and is capable of storing fluid.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3761

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 3,8,13,28,33,38,51-59, are rejected under 35 U.S.C. 103(a) as being unpatentable over Young Sr. et al. (5188624) in view of Graef et al. (5225047).

Young discloses the invention substantially as claimed. See the above 102 rejection.

Young discloses that the 2<sup>nd</sup> stratum is desirably made from wood pulp fibers (cellulose fibers). Young does not disclose the cellulose fibers as being crosslinked cellulose fibers. Graef discloses that crosslinked cellulose fibers have advantages in disposable absorbent articles such as diapers when compared to normal untreated cellulose fibers.

Graef discloses that crosslinked cellulose fibers provide greater bulk and will hold retained liquid better under compressive forces encountered during use of the article.

Crosslinked cellulose fibers will provide an improvement in performance when compared to untreated cellulose fibers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Young with crosslinked cellulose fibers for the 2<sup>nd</sup> stratum as disclosed by Graef so that increased bulk and improved retention of fluid under compressive forces may be obtained. Using



Art Unit: 3761

crosslinked cellulose fibers in the 2<sup>nd</sup> stratum of Young will provide an improvement over the untreated cellulose fibers that Young discloses.

### ***Double Patenting***

13. Claims 1,3,26,27,28,29,51,52, are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1,25,62,63,65-67,69, of copending Application No. 09/137,503. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1-67<sup>1</sup> are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33,70,71,73-75,77, of copending Application No. 09/137503. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference in the claims is that the currently pending claims fail to recite the preamble limitation of "form formed". Failure to claim an element (deletion of an element) is considered

Art Unit: 3761

obvious. Common ownership of claims of overlapping scope must be maintained and this is another reason for a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 09/624262. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims simply fail to claim the "absorbent material" recited in the claims of 09/624262 and there is minor changes of language in the claims. The deletion of an element is considered obvious. Common ownership of claims of overlapping scope must be maintained and this is another reason for a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 1-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-67 of copending Application No. 09/621167. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims is the deletion of the preamble term "wet laid". The deletion of an element is considered obvious. Common ownership of claims of overlapping scope must be maintained and this is another reason for a terminal disclaimer.

Art Unit: 3761

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 1-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 09/624263. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences in the claims is the deletion of the limitation of "absorbent material" and failure to claim "wet laid". The deletion of an element is considered obvious. Common ownership of claims of overlapping scope must be maintained and this is another reason for a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claims 1-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,9,13,14,20,21,25,26,28,29,30,32 of copending Application No. 09/620947. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences in the claims is the deletion of the term "wet laid". The deletion of an element is considered obvious. Common ownership of claims of overlapping scope must be maintained and this is another reason for a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 3761

20. Claims 26-29,31,36,41,45-47,51,52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,9,11,17,20,21,29,31,37-42,46 of copending Application No. 09/624081. Although the conflicting claims are not identical, they are not patentably distinct from each other because the deletion of claiming the "absorbent material" and the term "foam formed" is considered obvious. The deletion of an element(s) is considered obvious. Common ownership of claims of overlapping scope must be maintained and this is another reason for a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

21. Claims 1-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32,81-109 of copending Application No. 09/326213. Although the conflicting claims are not identical, they are not patentably distinct from each other because the deletion of claiming the 3<sup>rd</sup> stratum and the materials from which it is made is considered obvious. Common ownership of claims of overlapping scope must be maintained and this is another reason for a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

22. Claims 1-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-67 of copending Application No. 09/620950. Although the conflicting claims are not identical,

Art Unit: 3761

they are not patentably distinct from each other because the deletion of claiming the term "foam formed" is considered obvious. Deletion of an element is obvious. Common ownership of claims of overlapping scope must be maintained and this is another reason for a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant should take notice that because of the large number of related pending applications and because the examiner has no way to know which of these may issue first, to be fully responsive to this office action the next response must include either a traversal of the double patenting rejections pointing out why they are not proper or a terminal disclaimer must be filed. This is to ensure that applications do not accidentally issue that should have had a terminal disclaimer filed. The examiner just has no way to know what case will issue first. Applicant's cooperation in this matter is appreciated.

***Allowable Subject Matter***

23. Claims 16-25, 41-50, 60-67, appear that they would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Westland et al. (5998511), Greiser et al. (5017426), Cook et al. (5360420), Suzuki et al. (4704112), and Butterworth et al. (4129132) disclose articles with entangled fibers or disclose crosslinked cellulose.

Art Unit: 3761

25. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



**DENNIS RUHL**  
**PRIMARY EXAMINER**

DR  
July 28, 2001